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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,600	07/13/2001	David Dolson	CISCP250/111194	3606
22434 7590 07/29/2009 Weaver Austin Villeneuve & Sampson LLP P.O. BOX 70250 OAKLAND, CA 94612-0250				
EXAMINER AN, SHAWN S				
ART UNIT 2621		PAPER NUMBER		
MAIL DATE 07/29/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/905,600

Applicant(s)

DOLSON ET AL.

Examiner

SHAWN AN

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 31-46 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 and 24-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 16-23 and 31 is/are rejected.
- 7) ☒ Claim(s) 32-38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. As per Applicant's instruction as filed on 4/03/07, claim 31 has been amended, and claim 30 has been canceled.

Response to Remarks

2. Applicant's remarks/arguments with respect to independent claims as filed on 4/03/07 have been carefully considered but are moot in view of the following new ground(s) of rejection.

Claim Objections

3. Claim 16 is objected to because of the following informalities: On claim 16 preamble, the recited "a computer readable medium containing instructions for ..., said instructions performing the steps of:" is not an acceptable/proper language in computer processing related claims.

However, an example of the acceptable/proper language in computer processing related claims follows:

"a computer readable medium encoded with computer executable instructions"
for

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-8 and 16-23 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention.

Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example,

claims 1 and 16 are directed to a computer readable medium containing instructions performing the steps of, and a method of determining if the content of a source MPEG-2 stream may be reduced, the method comprising the steps of:

- a) examining the source stream to determine if a sequence_display_extension follows the most recent sequence header and sequence extension;
- b) confirming that horizontal size is greater than the display horizontal size or that vertical size is greater than the display vertical size; and
- c) if steps a) and b) are met, reducing the content of the source stream to create a reformatted stream without any ties to a particular apparatus/structure.

Since dependent claims 2-8 and 17-23 are directed to further limitations based on claims 1 and 16, respectively, claims 1-8 and 16-23 as a whole do not fall within the statutory classes set forth in 35 U.S.C. 101.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parkerv. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 16, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tahara et al (6,560,282 B2).

Regarding claims 1, 16, and 31, Tahara et al discloses a video transcoder (abs.) configured to perform the following steps, and a method of determining if the content of a source MPEG-2 stream may be reduced, the method comprising the steps of:

a) examining the source stream to determine if a sequence_display_extension follows the most recent sequence header and sequence extension (col. 46, lines 40-67; col. 47, lines 1-21)(Note: the sequence_display_extension of the sequence layer is in the User Data area (see Fig. 39) of the picture layer of the bitstream, of which the sequence_display_extension (of the User Data shown in Fig. 39) clearly shows (in Fig. 39) following the most recent the sequence header and the sequence extension (Fig. 39);

b) confirming the horizontal size and the display horizontal size as well as the vertical size and the display vertical size (Figs. 40-41); and

c) reducing the content of the source stream to create a reformatted (the encoding process) stream (Fig. 19).

Therefore, if steps a) and b) are met, of which they are and by virtue of methodical sequence of logical steps, it would be contentiously obvious to perform step c) after meeting the steps a) and b) as discussed above in order to create a tangible end result, which is to create reformatted stream, and since Tahara et al discloses confirming the horizontal size and the display horizontal size as well as the vertical size and the display vertical size, it would have been considered quite obvious to a person of ordinary skill in the relevant art to recognize confirming the horizontal size being greater than the display horizontal size or the vertical size being greater than the display vertical

size in order to make sure the display horizontal/vertical size can fit within the given horizontal/vertical size as a way of double checking as desired by an user.

Allowable Subject Matter

8. Claims 2-8, 17-23, and 32-38 are objected to as being dependent upon a rejected base claims 1, 16, and 30, respectively, but would be allowable (contingent upon overcoming the 101 rejections for claims 1-8 and 16-23, and overcoming the claim objection for claim 16): if any one of claims 2, 17, and claim 32 is rewritten in independent form including all of the limitations of the base claims 1, 16, and 31, respectively, and any intervening claims.

Dependent claims 2, 17, and 32, recite novel features comprising:
calculating the values of: width_mb and height_mb;
calculating the values of: top, bottom, left, and right;
calculating the values of: top_mb, bottom_mb, left_mb, and right_mb;
substituting/introducing into the reformatted stream a portion of new horizontal size for horizontal size and a portion of new vertical size for vertical size; and
substituting/introducing into the reformatted stream a portion of new horizontal size for horizontal size extension and a portion of new vertical size for vertical size extension.

The art of record fails to anticipate or make obvious the novel features. Accordingly, if the amendments are made to the claims listed above, and if rejected claims are canceled, the application would be placed in condition for allowance.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to *Shawn An* whose telephone number is 571-272-7324.

10. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHAWN AN/

Primary Examiner, Art Unit 2621

7/27/09

